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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,225	11/20/2001	Tony F. Rodriguez	P0490	4167
23735 7590 04/12/2010 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
EXAMINER				
RAMAN, USHA				
ART UNIT		PAPER NUMBER		
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04/12/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/002,225

Applicant(s)

RODRIGUEZ, TONY F.

Examiner

USHA RAMAN

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Response to Arguments

1. Applicant's arguments filed January 20, 2010 have been fully considered but they are not persuasive.

Applicant argues (see Remarks, page 5) that, "applicant expressly contemplated combining described embodiments with those incorporated by reference". However examiner notes that applicant's disclosure (see disclosure page 4, lines 23-25) stating that, "the interchanging and substitution of these teachings with other teachings in this and the incorporated-by-reference patents/applications are also contemplated" is merely a generalized incorporation, without contemplating specific embodiments incorporating specific features/functions/devices into specific devices/features of the incorporated references. Accordingly it is noted that such a blanket incorporation does not satisfy the requirements of 35 USC 112.

Applicant argues (see Remarks, page 6) that, "Rhoads.....does not have in software instructions in said memory causing the processor to establish a layered stack of protocols, in combination with other features of claim 21". Examiner respectfully disagrees. Rhoads discloses that protocols providing email/internet access can additionally convey Bedoop data (col. 46, lines 38-40). Accordingly the cell phone comprises establishing a layered stack of protocols at least for the conveyance of Bedoop data as well as internet/email access. Furthermore, Rhoads discloses that the watermark is made available to an application program (higher layer) through APIs (col. 49, line 67-col. 50, line 2), wherein such APIs comprise a

set of interface protocols (col. 27, line 49-50). Accordingly, such protocols can be used for the detection/extraction of the Bedoop data. Therefore it is submitted that Rhoads comprises software instructions in memory causing the processor to establish a layered stack of protocols for at least the reasons stated above.

Because the applicant is not one of the listed inventors in the Rhoads et al. patent and because the claimed subject matter is directed entirely to the contents disclosed in the Rhoads et al. patent as discussed above, the ambiguity regarding inventorship of claims 21-28 remains outstanding and the rejection of the claims under 102(f) are maintained as well.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant remarked in correspondence filed August 13, 2008 that, "there is no showing that the '571 patent teaches each element of the rejected claims. (For example the '571 patent is silent on software instructions causing a process to

establish a layered stack of protocols, etc.)". While applicant has generally incorporated by reference application 09/571,422 (now US Pat. 6,947,571), applicant does not specify the context for incorporating the aforementioned application that would convey any specifics of how the how the incorporated reference relates to or is tied to the disclosed invention. As such, applicant was not in possession of embodiments combining features of the instant application with features of the '422 application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

5. Claims 21-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads et al. (US Pat. 6,947,571).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but

not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 21, Rhoads discloses a handheld cell phone having a processor (col. 45, lines 30-31), memory (col. 46, lines 63-64), a wireless interface (it is noted that a cell phone has a wireless interface), one or more input devices including a 2D image sensor (col. 45 lines 29-30), and one or more output devices including a display screen (col. 45, lines 37-43), the handheld cell phone operative to make phone calls (col. 46, line 57), send email (col. 46, lines 37-38), and display received video data (col. 46, lines 52-53), the handheld cell phone characterized by a watermark decoder (col. 45, lines 29-32, wherein Bedoop data is digitally watermarked in objects) operative to decode plural-bit watermark data steganographically embedded "in band" within content data received (objects maybe electronic objects such as video, col. 49, lines 24-27, col. 48, lines 32-36) using the wireless interface (incoming video content data is received using wireless interface, col. 46, line 53) and processed by said handheld cell phone (col. 45, lines 30-35) the handheld cell phone further comprising software instructions in said memory (col. 45, lines 33-35) causing said processor to establish a layered stack of protocols (col. 46, lines 38-40) and a software interface (API) through which a request to invoke watermark decoding functionality can be passed down from a higher layer to said watermark decoder (col. 45, lines 34-35, decoding effected by hardware by an executing software, therefore software, i.e. higher layer, invokes hardware decoder),

and through which results of watermark decoding can be returned up to said higher layer col. 49, lines 66-col. 50, line 4), the software interface serving to mask or hide implementation details of said watermark decoder from said higher layer (higher layers mask or hide implementation details of lower layers), wherein said higher layer is operative to employ said decoded watermark data in connection with an application selected by a user (col. 45, lines 52-55, lines 65-67 and col. 46, lines 1-6).

With regards to claim 22, Rhoads further discloses wherein said higher layer is operative to render content to a user, the rendered content including the digital content from which the watermark was decoded (col. 46, lines 52-53), and auxiliary content obtained by reference to said decoded watermark data (col. 45 lines 49-55, lines 65-67).

With regards to claim 23, Rhoads further discloses wherein the handheld cell phone with which the watermark decoder is operative to decode watermark data from image data captured from the 2D image sensor (col. 45, lines 28-32, col. 46, lines 46-48 and col. 49, lines 24-27).

With regards to claim 24, Rhoads further discloses, wherein the watermark decoder is operative to decode watermark data from audio data (col. 49, lines 52-26).

With regards to claim 25, Rhoads further discloses the watermark decoder is operative to decode watermark data from received video data (col. 49, lines 52-26).

With regards to claim 25, Rhoads further discloses wherein said application comprises an email application (certain Bedoop data may invoke application for emails, col. 12, lines 44-49, lines 52-53, col. 31, lines 27-29, lines 43-44).

With regards to claim 27, Rhoads further discloses wherein said application comprises a phone application (col. 45, lines 56-58).

With regards to claim 28, Rhoads further discloses wherein the watermark decoder is operating to decode watermarks (see Rhoads, claim 1, col. 7, lines 31-36).

6. Claims 21-28 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

As discussed in the 102(e) rejection above, all the claimed limitations are anticipated by Rhoads et al. patent. It is additionally noted that applicant is not one of the listed inventors in the Rhoads et al. patent. As the claimed subject matter is entirely directed to the contents disclosed in the Rhoads et al. patent, it appears that Rhoads et al. remain the inventors for the claimed invention, i.e. applicant does not appear to be the inventor of the invention recited in the claims. As such ambiguity regarding inventorship of claims 21-27 remains outstanding.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **USHA RAMAN** whose telephone number is **(571)272-7380**. The examiner can normally be reached on **Mon-Fri: 8am-4:30pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on **(571) 272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art
Unit 2424

/Usha Raman/